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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,040	06/15/1999	KENLEY H. WONG	081862.P151	4869

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EXAMINER

DO, NHAT Q

ART UNIT PAPER NUMBER

2663

DATE MAILED: 01/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/334,040

Applicant(s)

WONG ET AL.

Examiner

Nhat Do

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7 is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 9 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claim 9 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed on 10/31/03 for claim 3 have been fully considered but they are not persuasive.

Applicant argues that the second network element identifies and drives itself into the first networking protocol of Armistead et al is different from applicant's invention. (Remark page 8, third paragraph).

In reply, claim 3 recites: "the second networking device automatically identifies from the cable the first networking protocol and drives itself into the first protocol".

Armistead et al disclose the device detects whether an E1 or T1 signal is present by reconfiguring to each standard in turn, attempts to establish lock, and moves on if lock is not established (Col. 2, lines 25-35). The examiner is in the position 'detecting whether an E1 or T1 signal is present by reconfiguring to each standard in turn' is equivalent to the claimed "automatically identifying from the cable the first networking protocol", and 'attempting to establish lock' is equivalent to the claimed "driving itself into the first protocol".

Based on the language of the claim, the examiner sees no difference between the claimed invention and the reference.

Applicant also request an evidence for proving it is well known that E1 unbalanced standard uses 75 Ohms impedance coaxial cable connector, E1 balanced

standard uses 120 Ohms RC48 cable connector, and T1 balanced standard uses 100 Ohms RC48 cable connector.

In reply, the proof can be found in the U.S. Patent No. 6,112, 232 to Shahar et al (Col. 7, lines 35-59), which is previously cited as a reference.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,792,986 to Garner et al.

Garner et al disclose a method comprising:

Coupling a pair of network device together with a cable (coupling a phone 10 to an external device through the cable 46 (Fig. 1));

Detecting in a first device of the pair from the cable a mode of the second device by monitoring an unused contact of a cable connector for a predetermined voltage level (detecting in the phone 10 whether the external device is in emergency mode by monitoring at an unused pin to check if the emergency switch is grounded (Fig. 5; col. 7, lines 37-59);

Driving the first device into the mode detected (when the emergency switch is grounded, working in the emergency mode by sending emergency message (Col. 7, lines 54-59).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,553,117 to Armistead et al in view of Patent No. 6,072,794 to Kang.

Kang disclose a unit comprising:

A processor (the processor 250 (Fig. 2));

A framer controlled by the processor (the framer 314 receives signaling bits provided from the processor 250 to form E1 frames (Fig. 3; col. 3, lines 55-59);

An interface module having a network interface and to detect a voltage at an unused contact to identify a networking protocol for which the apparatus should be configured (the line card and the processor constitute an interface module, wherein the line card is the network interface and the processor 250 detects a voltage at the unused contact 316 to identify a the network protocol for which the unit should be configured (Col. 4, lines 11-23).

A memory coupled to the processor, the memory stores a first set of configuration information and a second set of configuration information (Since Kang discloses the processor executes programs corresponding to the respective line cards 310, which uses E1 standard and 410, which use T1 standard (Col. 4, lines 20-23). Furthermore, it is well known in the art a processor requires memory for storing specific

instructions in form of programs, it is inherent that there is a memory coupled to the processor, and the memory stores a first set of configuration instruction (E1 program for controlling the line card 310) and a second set of configuration instruction (T1 program for controlling the line card 410)), the first set to configure the framer to communicate across a communication network using a first networking protocol (the controller controls the framer 314 to form E1 frame and output E1 frame to the line card 312 (Col. 3, lines 50-59)).

Kang fails to disclose the second set of configuration information configures the framer to communicate across the communication network using a second network protocol (the T1 program controls the framer 314 to form T1 frame and output T1 frame to the line card 312).

Armistead et al disclose a framer controlled by a processor for processing either E1 or T1 protocol (Col. 4, lines 43-53). A skilled artisan would have been motivated to modify the unit of Kang by modifying the framer 314 so that it can process either E1 or T1 protocol in order to avoid the situation of supplying separate products to users who wish to support both standards as taught by Armistead et al (Col. 1, lines 59-67).

Consequently, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to make the second set of configuration information configure the framer to communicate across the communication network using a second network protocol.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,553,117 in view of Patent No. 6,250,936 both to Armistead et al.

Armistead et al disclose in '117 a system comprising:

A first networking device operates in a first networking protocol (Armistead et al disclose in figure 3 the module 22 connects to the cable 20, it is inherent there is a first device connected to the cable at the other end. Furthermore, Armistead et al disclose the module 22 detects whether an E1 or T1 signal is present by reconfiguring to each standard in turn (Col. 2, lines 25-35), the examiner is in the position which protocol that is present in cable is the first protocol);

A second networking device couples to the cable, the second networking device automatically identifies from the cable the first networking protocol and drives itself into the first protocol (the module 22 detects whether an E1 or T1 signal is present by reconfiguring to each standard in turn, attempting to establish lock, and moves on if lock is not established (Col. 2, lines 25-35)).

Armistead et al fail to disclose in '117 a cable has an RJ-48 connected at a first end and a BNC connected at an opposing end.

Armistead et al disclose in '936 a cable has an RJ-48 connector at a first end and a BNC connector at an opposing end (figure 12).

Since Armistead et al disclose the system can support all 75, 100 and 120 Ohms standards (Col. 4, lines 53-65). Since it is well known that 75 Ohms standard implies E1 unbalanced standard, which uses BNC coaxial connector, 100 and 120 Ohms standards imply T1 and E1 balanced standard, which uses RJ 48 connector. A skilled artisan would have been motivated to use the cable in '936 for the system in '117 in the

situation when one end uses E1 unbalanced standard and the other end uses T1 or E1 balanced standard.

Consequently, it would have been obvious to a person having ordinary skill in the art by the time the invention was made to make the cable has an RJ-48 connected at a first end and a BNC connected at an opposing end.

### ***Allowable Subject Matter***

8. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 4-7 are allowed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nhat Do whose telephone number is (703) 305-5743. The examiner can normally be reached on 9:00 AM - 6:00 PM (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9306.

Nhat Do  
Examiner  
Art Unit 2663

ND

January 6, 2004.

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER  
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1/7/04